

REMARKS

In the Office Action mailed January 29, 2008, the Examiner rejected all pending claims 1-25 and 29-30 under 35 U.S.C. § 103(a) as being unpatentable over Barclay (Publication 2003/0119522) in view of Hussain (Publication 2002/0037750).

Applicants have amended claim 1 to include the subject matter of claim 12, and have canceled claim 12. Applicants amended claims 2, 6 and 13-15 to comply with these changes. Applicants have also amended independent claim 29 to be in a similar form as claim 1. Applicants have reviewed the cited art and claim rejections, and request reconsideration in view of the above amendments and the remarks below.

Obviousness is a question of law based on underlying factual inquiries. The factual inquiries include (i) determining the scope and content of the prior art, (ii) ascertaining the differences between the claimed invention and the prior art, and (iii) resolving the level of ordinary skill in the pertinent art. (MPEP § 2141). In the present case, Applicants submit that differences between the cited art and the claimed invention demonstrate a lack of sound factual underpinnings to support a *prima facie* case of obviousness. The teachings within the cited art do not reasonably or logically lead to the claimed invention as defined by independent claims 1, 22 and 29.

Claim 1 recites, “in a client station, detecting a request to initiate a voice call,” and “responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service, wherein the message indicates a location granularity preference of a user of the client station.” Claims 22 and 29 recite similar language.

The Examiner cited Barclay as teaching “in a client station (101), detecting a request to initiate a call (para. #0019); and responsive to the request, sending from the client station (101) into a network a message indicating how to carry out a location-based service (para. # 0018-

0020).” (Office Action, p. 2). The Examiner then cited to Hussain as specifically teaching detecting a request to initiate a *voice* call, and for sending a notification message along with the call initiation message.

However, the teachings cited by the Examiner do not encompass the claimed invention. As Applicants stated in the response to the Office Action mailed January 18, 2006, Barclay fails to teach the claimed function of sending a message indicating how to carry out a location-based service *in response to* a request to initiate a voice call. Applicants have clarified that the message “indicates a location granularity preference of a user of the client station.”

Barclay discloses that a service provider initially provides a customer with options for (i) the granularity of received location information, (ii) the format of received location information, and (iii) the ability of others to access the customer’s location information. (para. [0011], [0016-0018]). After selecting the preferred options, the customer sends the selected options to the service provider, and the service provider stores the selected options in a customer profile. (para. [0016]-[0018], Fig. 3). Subsequently, when a call is placed to or by a customer, the service provider then retrieves the customer’s selected options from the customer profile to provide the parties to the call with the customer’s location information. (para. [0019]-[0020], Fig. 4).

Applicants do not find in Barclay teachings of responsive to the request to initiate a voice call, sending from the client station into a network a message indicating how to carry out a location-based service, wherein the message indicates a location granularity preference of a user of the client station, as in claims 1, 22 and 29.

As discussed, Barclay teaches a customer setting up a profile by sending selected options to the service provider, which maintains the selected options in a customer profile. The customer’s communication device in Barclay only sends the options to the service provider to set the options of his/her profile. (Fig. 3). Thus, Barclay fails to teach Applicants’ claimed function

of sending a message indicating how to carry out a location-based service in response to a request to initiate a voice call.

In contrast, Barclay teaches that, in response to a request to initiate a call, the service provider will determine if the customer has set the location enable identifier in his profile, and if so, the service provider will obtain the location format and granularity level from the customer profile stored by the service provider. (para. [0019]-[0020]). The customer's device does not send a message indicating this information at this time. Thus, Barclay fails to teach Applicants' claimed function of "sending from the client station into a network a message indicating how to carry out a location-based service, wherein the message indicates a location granularity preference of a user of the client station," in response to a request to initiate a voice call.

The Examiner cited to Hussain as specifically teaching detecting a request to initiate a *voice* call, and for sending a notification message along with the call initiation message, and asserted that the combination of Hussain and Barclay renders the present claims obvious. Applicants disagree. As Applicants stated in the response to the Office Action mailed February 8, 2007, Hussain teaches a signal exchange for providing location information of mobile equipment (ME) to a Police System Emergency Terminal (PSET). Hussain teaches that when the ME detects that a preselected number has been dialed, the ME initiates a dual communication to an MSC/VLR that includes a voice and a data portion. The voice portion is forwarded from the MSC/VLR to the PSET, while the data portion (which includes location information) is forwarded to a service control server (SCS). (para. [0134]-[0142]).

Like Barclay, Hussain also does not teach "in a client station, detecting a request to initiate a voice call," and "responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service, wherein the message indicates a location granularity preference of a user of the client station," as in claim 1 and

similarly in claims 22 and 29. Within Hussain, the data call portion sent from the originating ME does not indicate how to carry out a location-based service, and secondly, does not include “a location granularity preference of a user of the client station.” In contrast, the data call portion includes location information from the ME or a request to determine the location of the ME. (para. 0139, lines 7-11).

The combination of the teachings within Barclay and Hussain do not render the present claims obvious. Barclay teaches a customer sending a message indicating location granularity information to a service provider to set up his/her profile with the service provider. Hussain teaches detecting a call and then initiating a dual communication that includes a voice and a data portion, neither of which include location granularity information. The Examiner attempted to combine Barclay with Hussain to render the claimed function of “in a client station, detecting a request to initiate a voice call,” and “responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service, wherein the message indicates a location granularity preference of a user of the client station,” obvious. Particularly, the Examiner asserted that Hussain teaches the timing of sending the message in response to detecting a call and Barclay teaches the content of the message. However, it is the responsive nature of the elements of the present invention that render the invention novel and non-obvious. For example, it is only after detecting a voice call that the client station then informs the network how to carry out a location-based service. Combining teachings of a user setting up a profile as in Barclay, with generic teachings of sending a notification into the network as in Hussain, does not encompass the entirety of the claimed invention.

The differences between the cited art and the claimed invention demonstrate a lack of sound factual underpinnings to support a *prima facie* case of obviousness. The Examiner has not shown that it was known for a client station to detect a request to initiate a voice call, *and then to*

responsively send into a network a message indicating how to carry out a location-based service that indicates a location granularity preference of a user of the client station, as in the claims 1, 22 and 29. Thus, the Examiner has not clearly articulated reasons why the claimed invention would have been obvious using sound factual underpinnings, as required by MPEP § 2143.

CONCLUSION

In view of the foregoing, Applicants submit that all of the pending claims are in condition for allowance over the cited references, and Applicants therefore respectfully request issuance of a Notice of Allowance.

Applicants note that the present Office Action is the seventh Office Action issued for the present patent application. Due to the lengthy prosecution of this application, Applicants request the Examiner to call the undersigned below at (312) 913-3331 if the Examiner has any uncertainties about issuing a Notice of Allowance.

Respectfully submitted,

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